

REMARKS**Overview**

Claims 1-29 are presented for examination. Claim 1 has been amended to become grammatically correct and Claim 29 is new. No new matter has been added.

Claim Rejections - 35 U.S.C. § 102(b)

Claims 1-9, 14, 21-27 were rejected under 35 U.S.C. § 102(b) as being anticipated by Polley (U.S. Patent No. 6,040,512). The Examiner argues that Polley discloses the claimed string instrument pick having a relatively thin piece of material that resists sliding and promotes gripping, is applicable to the gripping portion on the pick, uses material that fits within the dimensions of the pick and can be retrofitted to an existing pick. The Examiner also argues that Polley discloses an apparatus having removable adhesion to a pick by service tension without residue, thus anticipating the claims.

A. Legal Standard for Anticipation

For a proper anticipation rejection, the cited prior art reference must disclose "each and every element of the claimed invention, arranged as in the claim." Lindemann Maschinenfabrik gmbH v. American Hoist & Derrick Co., 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). The absence from a prior art reference of any claimed element negates anticipation. Minnesota Mining & Mfg. Co. v. Johnson & Johnson Orthopedics, Inc., 976 F.2d 1559, 1565 (Fed. Cir. 1992). The burden is on the Patent Office to produce the factual basis for its rejection. In re Warner, 154 U.S.P.Q. 173, 177 (CCPA 1967).

B. Anticipation Rejections

Claim 1 from which claims 2-9, 14 and 21 all depend, requires a "relatively thin" material to resist sliding and promote gripping by human fingers and is applicable to the gripping portion of an instrument pick. The Examiner asserts this is anticipated by Polley, however, as noted in Polley, the material used to provide the non-slip effect in Polley is the hook closure material component of a hook and loop fastener, commonly sold under the trademark Velcro (Polley, col. 2, lines 61-63). However, Polley continues to state that utilizing the hook closure material on both sides of the instrument pick is not preferred because it results in a thick, unfamiliar feel which is undesirable for many musicians (col. 3, lines 9-12). Applicant's invention, conversely, utilizes a non-slip material which is relatively thin, compared to the hook fastening material used by Polley. Thus, Polley does not disclose use of a relatively thin non-slip material, and thus does not anticipate claim 1.

Claim 1 is likewise not disclosed in Polley because there is no disclosure in Polley indicating any use of relatively thin material, nor is there any suggestion to do so. In fact, while vaguely noting that thinner material is superior, Polley provides no teaching to solve the problem of the thickness of the material (col. 3, lines 9-12).

Regarding claim 2, Polley does disclose the attachment of the hook closure material by adhesion to the gripping portion of a pick (col. 3, lines 13-15). However, because claim 2 depends from allowable claim 1, claim 2 should likewise be allowed.

Regarding claim 3, there is no indication or teaching in Polley regarding removably adhering the non-slip material to the instrument pick. Instead, Polley describes removable attachment in the context of adhering the pick to the instrument with which it is to be used, specifically a guitar (col. 3, lines 25-27). Removable adhesion of the material, in fact, would be

contrary to the goals of Polley. For example, Polley states that one of the objects of the invention is to produce a guitar pick which provides the dual purposes of enhancing gripping qualities of the pick and allowing the pick to be attached onto the side of the guitar with which the pick will be used (col. 1, lines 66-67-col. 2, lines 1-4). If the loop closure material were removably adhered to the guitar pick, as suggested by the Examiner, the second purpose of Polley would be completely frustrated. This is because the removable adhesion described in Polley is to be between the pick and the guitar, not between the pick and the non-slip material. Were the non-slip material removably adhered, the pick would not be guaranteed to remain removably adhered to the guitar during use. In addition, nowhere in Polley is removal of the hook closure material mentioned. Therefore, Polley does not anticipate claim 3.

Claim 3 is likewise not rendered obvious by Polley. As noted previously, Polley does not even mention removal of the non-slip material from the instrument pick. Polley also provides no motivation to remove such material, as it would frustrate one of the goals of the invention, as noted above. For these reasons, claim 3 is not rendered obvious by Polley and should be allowed. Likewise, claims 4-5 should be allowed, because they ultimately depend from an allowable base claim 3.

Claim 6 requires that the non-slip material be adapted so that it does not substantially change the size, shape, mass, or function of a pick. Polley likewise does not anticipate claim 6. As noted previously, one of the potential problems of using the invention disclosed in Polley is that the hook closure material can produce a thick, unfamiliar feel that is undesirable to many musicians (col. 3, lines 9-12). The hook closure material of Polley substantially changes the size of the pick. This size change results in a degradation of quality and preference of use by musicians (col. 3, lines 9-12). As a result, Polley does not anticipate claim 6.

Likewise, claim 6 is not rendered obvious by Polley. While Polley notes in general that it is superior to have a thinner non-slip surface, Polley offer no potential solution for this problem, rather simply notes that the problem exists (col. 3, lines 9-12). While the overall concept of applying non-slip materials to picks is disclosed, there is no teaching or suggestion regarding minimizing the thickness of the non-slip material. As such, claim 6 is not rendered obvious by Polley.

Turning to claims 7-9, Polley does disclose material that is sized to fit within perimeter dimensions of a pick, can be retrofitted to an existing pick, and can be used for a variety of sizes and shapes of picks. However, because each of these claims depends from allowable base claim 1, claims 7-9 should likewise be allowed.

Turning to claim 14, this anticipation rejection should be withdrawn. Claim 14 depends from claim 13, which likewise depends from claim 1. However, the Examiner has not rejected claim 13 as anticipated by Polley. Therefore, because claim 14 depends from claim 13, and claim 13 is not anticipated, claim 14 likewise cannot be anticipated. In addition, claim 14 ultimately depends from allowable base claim 1, and likewise should be allowed on that basis.

Regarding claim 21, Polley does disclose usage of the non-slip material in combination with a stringed instrument pick. However, because claim 21 depends from allowable claim 1, claim 21 should likewise be allowed.

Claim 22 requires, among other things, "a relatively thin piece of material" which assists in resisting sliding and promoting grip by human fingers. As noted in the context of claim 1, Polley does not disclose this relatively thin piece of material, but rather discloses a thick material which is not desirable for many musicians (col. 3, lines 9-12). As such, for this reason and the

reasons mentioned in conjunction with claim 1, claim 22 likewise is neither anticipated nor rendered obvious by Polley.

Turning to claims 23-24, Polley does disclose applying the non-slip material to a second surface of the pick and that the material is cohesive to the gripping portion of the pick. However, as these two claims depend from allowable base claim 22, they are likewise allowable.

Claim 25, once again, requires a "relatively thin" material that resists sliding and promotes gripping. For the same reasons mentioned in the context of claims 1 and 22, this limitation is not present in Polley nor does Polley render this limitation obvious. Therefore, claim 25 should likewise be allowed.

Turning to claim 26, as mentioned in the context of claim 3, there is absolutely no mention of removable adhesion in Polley between the pick and the non-slip material. The only mention of removable attachment is between the pick and the guitar, after the hook and loop fasteners have been applied to each. Thus, this additional limitation is completely lacking in the Polley disclosure, and claim 26 should therefore be allowed for this reason alone. In addition, however, claim 26 depends from allowable claim 25, and should be allowed on that basis as well.

Turning to claim 27, Polley's non-slip material does materially affect size, shape, mass, function, or applicability of the pick. As noted previously, the usage of the hook closure material by Polley can provide a thick, unfamiliar feel that is undesirable to many musicians (col. 3, lines 9-12). Therefore, Polley's disclosure does not meet this limitation of claim 27 and claim 27 should be allowable on that basis. As discussed in the context of claim 6, Polley likewise does not render claim 27 obvious, and should therefore be allowed.

Claim Rejections - 35 U.S.C. § 103(a)**A. Legal Standard for Obviousness**

In establishing a *prima facie* case of obviousness, the Examiner must provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. *In re Chu*, 66 F.3d 292, 298 (Fed. Cir. 1995). As the Board of Patent Appeals and Interferences has stated, "citing references which merely indicate that isolated elements and/or features recited in claims are known is not sufficient bases for concluding that the combination of claimed elements would have been obvious." *Ex parte Hiyamizu*, 10 U.S.P.Q.2d 1393, 1394 (B.P.A.I. 1988). The Federal Circuit has explained that there must be "some objective teaching" leading to the combination. *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992). This showing must likewise be "clear and particular." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

B. Claims 10-13

Claims 10-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Polley in view of Jonathan (U.S. Patent No. 4,993,302). The Examiner argues that Polley discloses the claimed invention with the exception of the specific use of a flexible material. The Examiner fills in this missing limitation via Jonathan's usage of a rubbery moldable apparatus with a smooth surface for use with a stringed instrument pick.

Jonathan, however, only discloses the use of a flexible material in combination with additional adhesive to produce the final non-slip effect (Jonathan, Figures 1-4, col. 1, lines 34-36). Because the non-slip effects of Jonathan are gained only by the combination of the rubbery material and the non-hardening adhesive, one skilled in the art would not utilize the rubbery material from Jonathan alone in the context that Examiner suggests. Therefore, claim 10 is not

rendered obvious by Polley in view of Jonathan. In addition, claim 10 depends from allowable base claim 1, and should be allowed on that basis as well.

Turning to claim 11, nothing in either Polley or Jonathan discusses usage of a non-slip material made from liquid silicon, liquid plastic, or liquid latex. The Examiner provides no reason why one skilled in the art would utilize these three materials and, more importantly, how usage of these materials is taught by either Polley or Jonathan. As both references cited by the Examiner are totally missing this limitation, claim 11 is not rendered obvious by Polley in view of Jonathan. Likewise, claim 11 depends from allowable claim 1, and should be allowed on that basis as well.

Turning to claim 12, neither Polley nor Jonathan discloses a non-slip material that is moldable. The Examiner likewise does not offer any reason why one skilled in the art would be able to take the teachings of Polley in view of Jonathan to arrive at Applicant's invention. As such, claim 12 is not obvious over Polley in view of Jonathan. Likewise, because claim 12 depends from allowable claim 1, claim 12 should be allowed on that basis as well.

Turning to claim 13, neither Polley nor Jonathan discloses a non-slip material wherein one side of the material is smooth. It is unclear how these two references could be combined to reach such a teaching. However, as the Federal Circuit has noted, it is improper to "imbue one of ordinary skill in the art with knowledge of the invention . . . , when no prior art reference or references of record convey or suggest that knowledge." W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1553 (Fed. Cir. 1983). Absent some teaching in either Polley or Jonathan, this obviousness rejection should be withdrawn, and claim 13 allowed. Likewise, claim 13 depends from allowable base claim 1, and should be allowed on that basis as well.

C. Claims 15-20

Claims 15-20 were rejected under 35 U.S.C. § 103(a) as being obvious over Polley in view of Smith (U.S. Publication No. 2002/0108483). Specifically, the Examiner states that Polley does not disclose the use of a thickness variance, but fills in this missing teaching by noting that Smith discloses a stringed instrument pick with a raised thickness variance.

Regarding claims 15-16, Smith does disclose a thickness variance used in the non-slip material. However, these claims both ultimately depend from allowable claim 1, and should be allowed on that basis.

Regarding claim 17, Smith discloses a textured non-slip material no thicker than between about half and six times the thickness of the pick. However, because this claim depends from allowable claim 1, this claim should likewise be allowed.

Regarding claims 18-20, these claims ultimately depend from allowable base claim 1, and should be allowed on that basis.

D. Claim 28

Applicant notes that claim 28, while presented to the Examiner, was neither rejected nor allowed. Because there have been no rejections or objections to claim 28, and in light of the references cited by the Examiner in regard to the other pending claims, Applicant believes claim 28 is in condition for allowance. In the event this is not the case, Applicant respectfully requests that a full shortened statutory period be granted to Applicant to respond to any rejections or objections the Examiner may make to claim 28.

New Claim 29

New claim 29 has been presented for consideration by the Examiner. Support for this claim can be found in original claims 1 and 3 and Figures 1-5. No new matter has been added.

For the reasons discussed in the context of claim 3, it is believed that claim 29 is also in condition for allowance. Communication to that effect is requested.

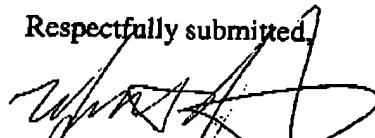
Conclusion

It is respectfully submitted that the application is in condition for allowance. Allowance of the pending claims 1-29 is therefore respectfully requested.

Please charge Deposit Account No. 26-0084 the amount of \$125.00 for the one new independent claim and also one new additional claim. No other fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

It is respectfully submitted that the Applicant has claimed an advance in the art that is neither disclosed nor suggested by the cited references. The claimed invention provides the combined advantage of a device and method that provides the musician with increased grippability of the pick without materially changing the feel, weight, profile, shape or characteristics of the pick. Reconsideration and allowance is respectfully requested.

Respectfully submitted,



MARK D. HANSING, Reg. No. 30,643
McKEE, VOORHEES & SEASE, P.L.C.
801 Grand Avenue, Suite 3200
Des Moines, Iowa 50309-2721
Phone No: (515) 288-3667
Fax No: (515) 288-1338
CUSTOMER NO: 22885

Attorneys of Record

- KVT-bja -